

1754

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of
Inventor(s): Mills

Group Art Unit: 1754

Appln. No.: 09/009,837

Examiner: Langel

Filing Date: 1/20/1998

Title: HYDRIDE FUEL AND EXPLOSIVE



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March 12, 2001
(March 11, 2001 = Sunday)

PETITION TO WITHDRAW TERMINAL DISCLAIMER

Hon. Asst. Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant respectfully petitions the PTO to withdraw the Terminal Disclaimer filed on January 14, 2000, relating to Applicant's copending U.S. Serial No. 09/009,455.

Applicant respectfully submits that the PTO's actions necessitated the filing of this Petition, which are described in the following paragraphs.

In the Office Action dated December 27, 1999, the Examiner rejected claims 17-299 under 35 U.S.C. § 101, as claiming the same invention as that of claims 17-299 of application serial No. 09/009,455. Applicant overcame that rejection with the arguments set forth in Applicant's Response dated January 14, 2000.

The Examiner also rejected present claims 17-299 under the judicially created doctrine of obviousness-type double patenting over claims 17-299 of the '455 application. In response to the obvious-type double patenting rejection, Applicant filed a Terminal Disclaimer on January 14, 2000.

The filing of that Terminal Disclaimer was based upon a verbal agreement from the Examiner that a Notice of Allowance would be issued imminently. That agreement was confirmed by the Amendment dated January 14, 2000, page 2, which states that the Terminal Disclaimer was filed "merely to facilitate an early Notice of Allowance." In that same response, Applicant set forth arguments why the double-patenting rejection was improper. Since the PTO has now violated its verbal agreement to issue an early Notice of Allowance, Applicant is within his rights to withdraw the Terminal Disclaimer and reargue that the double-patenting rejection was in error.

In the Office Action dated August 24, 1999 of the present application, the Examiner issued a restriction requirement between the following distinct inventions:

- Group I: Method of reacting a hydride ion with a proton, class 423, subclass 648.1;
- Group II: Method of thermally decomposing a compound comprising a hydride ion (an explosive), class 423, subclass 648.1;
- Group III: A fuel, class 423, subclass 648.1; and
- Group IV: Method for providing a hydride ion, class 423, subclass 648.1

Applicant filed a Response to the restriction requirement in an Amendment dated October 12, 1999, as follows:

In response to the Restriction Requirement, the Applicant elects the invention of Group III, drawn to a fuel (which includes rocket fuel), without traverse. The non-elected claims have been canceled and are being claimed in co-pending Divisional Applications. The subject matter of Group II is being claimed in Divisional Application U.S. Serial No. 098/009,455. The subject matter of Group IV is being claimed in Divisional Application U.S. Serial No. 09/009,294. The subject matter of Group I will be claimed in a Divisional Application.

On page 68 of an Amendment filed on September 20, 1999 in Applicant's copending '455 application, Applicant clearly stated that "the presently claimed invention ['455 application] recites the subject matter of Group II in the Restriction Requirement dated August 24, 1999, in Serial No. 09/009,837. Therefore, the present application ['455 application] has been amended to be a Divisional Application of Serial No. 09/009,837."

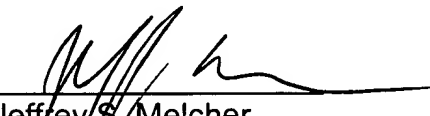
Since Applicant filed the '455 application in response to a restriction requirement, the full protections of 35 U.S.C. § 121 apply, and the PTO is barred from issuing a double-patenting rejection between the claims of the present application and Applicant's copending '455 application. See MPEP § 804.01.

Please charge any required Petition Fees to Deposit Account No. 50-687, under Order No. 62-226, for which purposes two copies of this Petition are enclosed.

Respectfully submitted,

Manelli, Denison & Selter, PLLC

By


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